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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,132	03/31/2004	Paul N. Dunlap	P01-020A	9157

7590 06/15/2006  
Curtis Castleman  
The Gates Corporation  
IP Law Dept. 10-A3  
1551 Wewatta Street  
Denver, CO 80202

EXAMINER

ASINOVSKY, OLGA

ART UNIT PAPER NUMBER

1711

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/815,132

Applicant(s)

DUNLAP ET AL.

Examiner

Olga Asinovsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>Sep. 06, 2005</u>   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to a vibration absorbing device comprising a rubber vibration absorbing element, classified in class 428, subclass 344, 355 R., 416.
  - II. Claims 9-15, drawn to a rubber composition, classified in class 525, subclass 242.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group II and Group I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as a hot pressure sensitive adhesive for other application and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Curtis Castleman on June 6, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 9-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. Claims 1, 7 and 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. In each claim the phrase "viscosity average molecular weight" technically is not correct. It should be -average molecular weight-.

***Claim Rejections - 35 USC § 102/103***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dunlap U.S. 2002/0162627.

The claimed invention is a vibration absorbing device comprising a rubber composition.

There is no structure of a vibration absorbing device.

Dunlap discloses a rubber composition for bonding directly to metal substrate for bonding two metal parts. A torsional vibration damper (claim 8) is readable in rubber-viscous vibration isolation dampers [0028]. A rubber composition is an elastomer that is cured in the presence of a free radical initiator. A rubber composition can include ethylene-propylene copolymer (EPM) and an isobutylene [0057] or isobutylene-isoprene elastomer [0056]. The rubber composition has damping capability wherein the Mooney viscosity of such elastomer is from 10 to about 100 at 125C, [0032]. The amount of the isobutylene (Vistanex MM L-140) or isobutylene-isoprene elastomer (Exxon Butyl 268) being present for the chemical formulation of said elastomer composition is within the range specified in the present claims, see Table 7, examples E-41 and E-42. Dunlap does not disclose an average molecular weight of said isobutylene or isobutylene-isoprene elastomer. However, it is reasonably to presume that a molecular weight of the isobutylene and isobutylene-isoprene elastomer in Dunlap invention would possess the same range limitation of the molecular weight specified in the present claims. It is

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burden on the applicant to provide the difference in order to overcome this rejection under *In re Fitzgerald* 205 USPQ 594.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Born et al U.S. Patent 6,361,643.

Born discloses a vibration damping rubber composition for a mechanical vibration utility.

A rubber composition includes liquid rubber and solid rubber. Liquid rubber or elastomers include polyisobutylene having a molecular weight in the range of below 20,000, column 4, lines 17 and 23-24. The percentage content of liquid rubber in the composition is between 5 and 50 wt.%, column 4, line 30. Solid rubbers include ethylene/propylene/diene rubber, column 7, line 57 and column 8, line 51. The rubber composition is used for reducing mechanical vibration in metal constructions.

It would have been obvious to one of ordinary skill in the art to select an isobutylene elastomer as a liquid rubber or an elastomer having a low average molecular weight in the wide definitions of liquid rubbers in Born invention since said liquid rubbers work within the same expectation for obtaining adequate results, and since it requires only ordinary skill of the worker in the art.

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13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andra et al U.S. Patent 4,961,254 in view of Born et al U.S. Patent 6,361,643 or Dunlap US 2002/0162627.

Claim 8 claims a torsional vibration damper comprising a free radical cured rubber vibration absorbing composition.

Andra discloses a process for manufacturing a torsional vibration damping device using a vulcanizable rubber mixture.

Born and Dunlap disclose a vulcanizable rubber mixture comprising ethylene-propylene rubber and an isobutylene or isobutylene-isoprene elastomer.

It would have been obvious to one of ordinary skill in the art to substitute a vulcanizable rubber mixture in Andra invention for a vibration damping rubber composition as disclosed in Born invention or Dunlap for the purpose of providing the claimed vibration absorbing rubber composition, since any chemical formulation for vulcanizable rubber mixture is readable in Andra invention for being expected to provide adequate results.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References have been considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Asinovsky whose telephone number is 571-272-1066. The examiner can normally be reached on 9:00 to 5:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.A

June 09, 2006



James J. Seidleck  
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